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IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

E. I. DU PONT DE NEMOURS & COMPANY,
Petitioner,

v.

PHILLIPS PETROLEUM COMPANY, PHILLIPS 66 COMPANY, and PHILLIPS DRISCOPIPE, INC.,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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STATEMENT PURSUANT TO RULE 28.1

The subsidiaries and affiliates of Phillips Petroleum Company, Phillips 66 Company, and Phillips Driscopipe, Inc., other than wholly-owned subsidiaries, are included in the list below:

Ace Limited
Alyeska Pipeline Service Company
Artic LNG Transportation Company
Bissendorf Biosciences GmbH
Canada Western Cordage Company, Limited
Canyon Reef Carriers, Inc.
Chisholm Pipeline Company
Cochin Refineries Limited
Colonial Pipeline Company
Corporate Officers and Directors Assurance Holding Limited
Crystal Limited
Dixie Pipeline Company
East Texas Salt Water Disposal Company
Explorer Pipeline Company
Great Yarmouth Port Labour Company Limited
Heat Transfer Research, Inc.
Insurance and Reinsurance Brokers (Bermuda) Limited
Iranian Marine International Oil Company—Iminoco
Kenai LNG Corporation
Multinational Gas and Petrochemical Company
Multinational Gas and Petrochemical Services Limited
Norland GmbH Fur Grundbesitz Und Industrieanlagen
Norpipe A.S.
Norpipe Petroleum UK Limited
Norsea Gas GmbH
Norsea Pipeline Limited

Oil Casualty Insurance Limited
Oil Insurance Limited
Papago Chemicals, Inc.
Phantex Pipeline Company
Phillips Carbon Black Limited
Phillips Petroleum International Andina, S.A.
Phillips Petroleum Singapore Chemical (Private) Limited
Phillips Petroleum Tanker Management, Limited
Phillips Petroleum Toray Inc.
Phillips—Imperial Petroleum Limited
Polar LNG Shipping Corporation
Renolit—Haus GmbH
Spodco Limited
Spodco—USA, Inc.
The Salk Institute Biotechnology/Industrial Associates Inc.
Venezoil, C.A.
Western Desert Operating Petroleum Company (WEPCO)

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STATEMENT OF THE CASE

DuPont filed its application for the '698 patent in 1956. The invention set forth in the claims of the patent is a group of chemical compositions called higher alpha-olefin copolymers. The patent was not issued until 1978. Throughout the twenty-two-year period during which the Patent Office had the application under review, DuPont maintained that it was the first to make higher alpha-olefin copolymers.

After the '698 patent finally issued, several potential licensees pointed out to DuPont that it had not informed the Patent Office of an array of prior art indicating that DuPont was *not* the first to make higher alpha-olefin copolymers. In a series of unusual agreements, DuPont granted eleven licenses for its "invention," but the licensees' obligations to pay running royalties were contingent on DuPont obtaining a reissue of the '698 patent after informing the Patent Office of the prior art that had not been revealed during the original prosecution.

DuPont filed its reissue application with the Patent Office in 1980. As it did during the original prosecution, DuPont steadfastly maintained that it was the first to make higher alpha-olefin copolymers. This time, however, the Patent Office had all the facts. In four successive Office Actions, the Patent Examiner rejected all of the claims of the '698 patent, holding, among other things, that *Phillips* had made higher alpha-olefin copolymers before DuPont had. DuPont's appeal from the last and final Office Action, which was issued on May 12, 1986, was stayed at DuPont's request when the trial of this case began in July 1986.[1]

By the time the trial began, DuPont could no longer credibly maintain that it was the first to make higher alpha-olefin copolymers. Not only had the Patent Examiner rejected this contention four times, but also Phillips was prepared to prove through a handwriting expert that DuPont had falsified a key document it had been relying on in the Patent Office to show an early date of invention.

Consequently, on the first day of trial—thirty years after filing its patent application—DuPont finally was forced to

[1] Phillips had refused to take a license, and DuPont filed this infringement suit in 1981. Phillips participated in the Patent Office proceedings by filing a request that the '698 patent be reexamined. The request was granted, and the reexamination and reissue proceedings were merged.

admit that Phillips made higher alpha-olefin copolymers before DuPont did. Rather than concede defeat, however, DuPont announced that the copolymers it had claimed as its invention were not really the invention of the '698 patent after all. Instead, said DuPont, the real invention of the '698 patent was the discovery (which is nowhere set forth in the claims of the '698 patent) that sometimes *higher* alpha-olefin copolymers have superior physical strength properties than *lower* alpha-olefin copolymers.

The District Court adopted DuPont's position that this discovery was the real invention of the '698 patent and that this discovery was a limitation that must be read into the claims from the specification.[2]

On appeal, Phillips pointed to the unbroken line of Federal Circuit cases holding that patents cannot be rewritten by reading limitations into the claims from the specification. DuPont asserted that no such rule could be derived from the Federal Circuit's prior holdings and that, in fact, Federal Circuit precedent required the opposite result.[3]

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[2] A patent consists of two basic sections—the claims and the specification. The claims are required by statute to "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112. In contrast, the specification should contain "a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." *Id.* Typically, when a claimed invention is similar but not identical to prior art, the specification will describe how the claimed invention has unexpected advantages over the prior art. Such an explanation of the invention's unexpected advantages helps establish that the claimed invention would not have been "obvious" in light of the similar prior art. See 35 U.S.C. § 103.

[3] DuPont now takes a different position, complaining that the Federal Circuit "woodenly adhered to the rigid, legalistic rule, stated

(Footnote continued on following page.)

The Federal Circuit reversed the District Court and ruled for Phillips. In accord with the well-settled distinction between interpreting ambiguous claim language and rewriting unambiguous claims, the Federal Circuit held that, while it is "entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim," it is improper to read limitations "into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim." (A7)

The Federal Circuit also explained that the rule against reading limitations into the claims from the specification—a rule that it "has consistently adhered to" (A6)—is fully consistent with *United States* v. *Adams,* 383 U.S. 39 (1966), the case principally relied on in DuPont's Petition. As the Federal Circuit noted, *Adams* involved an assertion that the claims were invalid for obviousness, not anticipation. (A7-8) The difference is crucial. An anticipation attack says, in essence, that the invention set forth in the claims is not novel. 35 U.S.C. § 102. When deciding the novelty issue, it is improper to rewrite the claims to set forth a different invention. An obviousness attack, in contrast, says that, though the claimed invention is not technically anticipated, it would have been obvious from similar prior art. 35 U.S.C. § 103. When deciding the obviousness issue, it is proper to look beyond the claims to the specification (and other materials) to determine whether the invention set forth in the claims would or would not have been obvious from the prior art. As the Federal Circuit explained, this is precisely what this Court did in *Adams.* (See pages 9-11, *infra.*)

(Footnote continued from preceding page.)

in several of its decisions, that Courts cannot alter what the patentee has chosen to claim as his invention and limitations from the specification are not to be read into the claims." (Pet. 13)

Having ruled in Phillips' favor on the threshold issue of claim interpretation, the Federal Circuit reversed the judgment as to four of the six claims based on DuPont's admission at trial that these claims, as written, were anticipated by Phillips' earlier higher alpha-olefin copolymers. (A9-10) The Federal Circuit therefore did not resolve several alternative grounds advanced by Phillips concerning the invalidity of these claims.

As to the two remaining claims, which did include specific property limitations, the Federal Circuit vacated and remanded for a new determination of whether these claims were also anticipated by or obvious from the prior art, including Phillips' earlier copolymers. The proceedings on remand are going forward.

Meanwhile, the Patent Office proceedings also remain unresolved. As noted, these proceedings were stayed when the trial began. When the District Court entered judgment for DuPont, the reexamination proceeding was vacated. When the Federal Circuit reversed the District Court, Phillips filed a petition to reinstate the reexamination proceeding. The Patent Office declined Phillips' petition, stating that it was untimely. The reissue proceeding, which was also stayed at DuPont's urging, was not dismissed. However, it can only be reactivated at DuPont's request. Faced with four Office Actions rejecting all of its claims, DuPont has chosen not to reactivate the reissue proceeding. In order to get the Patent Office proceedings back on track, Phillips recently filed a new reexamination request asking that, for the same reasons already found meritorious by the Patent Examiner, the claims of the '698 Patent be cancelled.[4]

Under the Patent Office's procedures, Phillips' new reexamination request will be granted or denied by December 21, 1988. If, as appears likely, the request is granted, the Patent

[4] Unlike in civil litigation, a dismissal of a reexamination proceeding does not bar the same party from filing a subsequent reexamination request. *See* 35 U.S.C. § 301.

Office will then resume its inquiry into whether the '698 Patent ever should have issued in the first place.

REASONS FOR DENYING THE WRIT

Certiorari would be inappropriate in this case. The overall controversy between the parties is likely to be mooted by a Patent Office decision rejecting DuPont's claims. Similarly, a District Court decision on remand as to the remaining claims could effectively moot the case. There is no reason for this Court to grant certiorari at this stage of the litigation when the specific issue presented may become moot and when, even if it does not, the issue will remain reviewable on certiorari from a final decision disposing of the entire controversy.

These considerations have particular force here because the specific issue presented by DuPont—whether claims in a patent can be rewritten by reading in limitations from the specification—would not warrant review even if the posture of the case were different. The Federal Circuit—the court created by Congress to bring consistency and coherence to patent law—has repeatedly held that, when the invention actually claimed in a patent is anticipated by prior art, a court should not rewrite the claims to set forth a different invention that may or may not be anticipated. This unbroken line of Federal Circuit cases does not conflict with *United States* v. *Adams* or any other decision of this Court. Rather, it is consistent with and compelled by this Court's precedent. Finally, the rule adhered to by the Federal Circuit is required by the structure and operation of the Patent Act.

A. The posture of this case renders certiorari inappropriate.

The District Court upheld the validity of all six of the claims at issue in this case. Four of these claims did not have any sort of property limitation concerning the strength of the copolymers. DuPont admitted that these claims as written were

anticipated by Phillips' earlier Witt and Leatherman copolymers. (A9-10) The Federal Circuit held these claims invalid.

As to the other two claims, which contained objective property limitations going to strength, the Federal Circuit vacated and remanded for new determinations of whether the claims are invalid for anticipation or obviousness. Remand was necessary in part because DuPont had persuaded the District Court to refuse to consider evidence, including a notebook prepared contemporaneously by a Phillips' researcher, indicating that the Witt and Leatherman higher alpha-olefin copolymers had the type of objective strength characteristics recited by DuPont in the two remaining claims. (A13-17)

If the two claims that do contain property limitations are held invalid on remand, the four that do not contain such limitations will be invalid *even if they are rewritten to include objective strength limitations.* In other words, a decision adverse to DuPont in the pending proceedings on remand would moot the issue presented by DuPont in its Petition.[5] On the other hand, once the controversy is finally resolved, this Court could issue a writ of certiorari to review and correct *any*

[5] It is theoretically possible that the issue would not be moot if, instead of asking that an objective strength limitation be read into the claims, DuPont is asking that some sort of "comparative" limitation be read into the claims. As far as can be discerned from DuPont's arguments, such a "comparative" limitation would require that prior art higher alpha-olefin copolymers not only have strength characteristics equal to DuPont's, but also have strength characteristics superior to those of "comparable" *lower* alpha-olefin copolymers. If this is DuPont's argument, certiorari should be denied because such a limitation, even if it could be read into the claims, would not set forth patentable subject matter. Rather, such a limitation would merely describe that one pre-existing (and thus unpatentable) composition is stronger than another pre-existing (and thus unpatentable) composition. *See General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U.S. 242, 248-49 (1945); *Titanium Metals Corp. of America* v. *Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985).

errors in the proceedings below, regardless of whether certiorari was denied earlier on a single issue. *See, e.g., Hughes Tool Co.* v. *Trans World Airlines,* 409 U.S. 363, 365 n.1 (1973); *Hamilton Shoe Co.* v. *Wolf Bros.,* 240 U.S. 251, 257-58 (1916).

An equally compelling reason to deny certiorari is the pendency of the Patent Office proceedings. The way the patent system is supposed to work is that, when an inventor submits his application, he or she also supplies the Patent Office with all prior art that might be material to the patentability of the claims. The Patent Office then reviews the claims in light of the pertinent prior art and decides whether the patent should issue.

Here, DuPont did not submit the pertinent prior art during the original prosecution. However, the prior art is now before the Patent Office. Given the Patent Examiner's repeated rejections of DuPont's claims in light of this prior art, it is altogether likely that Phillips' new reexamination request will be granted and DuPont's claims will be cancelled.

Moreover, even if Phillips' reexamination request is denied, there remains the reissue proceeding instituted by DuPont. This proceeding is currently stayed, and as a procedural matter only DuPont can reactivate it. Eventually, DuPont will have to do so if it hopes to obtain any royalties from the eleven licensees whose obligations are not triggered unless and until the patent reissues.

What appears to be going on here is that DuPont, fearing that it is destined to lose in the Patent Office, is holding off the reissue proceeding in the hope that this Court will rule in its favor in the infringement litigation. In such an event, DuPont could stand to recover damages from Phillips for infringing claims of a patent that the Patent Office is about to decide never should have issued in light of previously undisclosed prior art.[6]

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[6] A ruling for DuPont in this case, where Phillips has the burden of showing invalidity, would not be *res judicata* in the reissue

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This Court should not grant a discretionary writ of certiorari in an infringement suit when the Patent Office did not have the pertinent prior art before it in the original prosecution and the patentee is refusing to press forward in a reissue proceeding in which the pertinent prior art is before the Patent Office. Rather, this Court should deny DuPont's petition so that DuPont will be obliged to let the Patent Office do its job.

B. The Federal Circuit's ruling does not conflict with *United States* v. *Adams*.

In an effort to create a conflict between the Federal Circuit's ruling and a decision by this Court, DuPont quotes *United States* v. *Adams*, 383 U.S. 39, 49 (1966), for the proposition that "claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." (Pet. 9) However, immediately before stating the familiar principle that claim language can be construed in light of the specification, this Court also cautioned that "the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly." 383 U.S. at 49.

Thus, nothing in *Adams* suggests that this Court was abrogating the statutory requirement that the invention be particularly pointed out in the claims. 35 U.S.C. § 112, second paragraph. Indeed, in *Adams*, which involved a patent on a battery, it was admitted that the claims themselves set forth a combination of electrodes not shown in the prior art. Accord-

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proceeding, where DuPont has the burden of showing patentability. *Ethicon, Inc.* v. *Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988). In contrast, if the Patent Office rules against DuPont, there will be no patent whose claims could be infringed, and this case will be moot.

ingly, the battery was held to be novel and not anticipated under 35 U.S.C. § 102.[7]

As the Federal Circuit pointed out (A7-8) the real focus of *Adams* was whether the admittedly novel combination of electrodes would have been *obvious* under 35 U.S.C. § 103. When making that determination, this Court considered the factors outlined in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and gave due consideration to the main advantage of the claimed battery—its ability to be activated by water. *Adams*, 383 U.S. at 48. This advantage was described in the specification. When the question is obviousness, a court can look to the specification to determine the inherent advantages of the claimed invention. This is a far cry from reading limitations into the claims in order to distinguish them from prior art that concededly anticipates the claims as written.

DuPont's attempt to transform *Adams* into a novelty case by selective quotation is unavailing.[8] Any question about the

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[7] On the issue of novelty, the government's petition for certiorari stated: "It is true that Adams put together elements not actually combined before and obtained more favorable results, for some purposes, than had prior combinations." Petition for Certiorari at 11, *United States* v. *Adams*, 383 U.S. 39 (1966) (No. 65-66). The only § 102 challenge in *Adams* was based on the theory that a novel combination of separately known elements is anticipated by the known elements. This Court rejected this discredited approach. 383 U.S. at 48-50.

[8] For example, DuPont quotes the following:

> We believe that the Court of Claims was correct in concluding that the Adams battery is novel . . . .

DuPont Petition 11, quoting *Adams*, 383 U.S. at 50. DuPont omits the prior two sentences:

> It begs the question, and overlooks the holding of the Commissioner and the Court of Claims, to state merely that magnesium and cuprous chloride were individually known battery com-

(Footnote continued on following page.)

real issue in *Adams* is answered by this Court's observation at the outset of *Adams* that "this case is controlled on the merits by No. 11, *Graham, ante*, p. 1." 383 U.S. at 41. The referenced case is *Graham* v. *John Deere Co., supra*, which is the leading Supreme Court decision on obviousness and which has nothing to do with novelty.

That *Adams* does not sanction the approach urged by DuPont is clear from the fact that, if it did, it would have overruled a venerable line of Supreme Court cases rejecting efforts to read limitations into claims. As this Court stated as early as 1895:

> [W]e know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty. . . . The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claims and avoid a defense of anticipation, we should never know where to stop.

McCarty v. *Lehigh Valley R.R.*, 160 U.S. 110, 116 (1895). Far from overruling *McCarty*, this Court's *Adams* decision cites it favorably. 383 U.S. at 49.[9]

(Footnote continued from preceding page.)

> ponents. If such a combination is novel, the issue is whether bringing them together as taught by Adams was *obvious* in light of the prior art.

383 U.S. at 50 (emphasis supplied).

[9] Other Supreme Court cases to the same effect as *McCarty* are: *Evans* v. *Eaton*, 20 U.S. (7 Wheat.) 356, 432-35 (1822); *Brooks* v. *Fiske*, 56 U.S. (15 How.) 212, 214-15 (1854); *Merrill* v. *Yeomans*, 94 U.S. 568,.568-69 (1876); *Yale Lock Mfg. Co.* v. *Greenleaf*, 117 U.S. 554, 559 (1886); *White* v. *Dunbar*, 119 U.S. 47, 51-52 (1886); *McClain* v. *Ortmayer*, 141 U.S. 419, 423-24 (1891); *Cimiotti Unhairing Co.* v. *American Fur Refining Co.*, 198 U.S. 399, 410 (1905); *Altoona Publix Theatres Inc.* v. *American Tri-Ergon Corp.*, 294 U.S. 477, 487 (1935); *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 277 (1949).

Finally, when asking this Court to grant certiorari in order to overturn the longstanding rule that limitations cannot be read into claims from the specification, DuPont ignores the fact that a contrary approach to claim interpretation would contravene the structure and operation of the Patent Act.

The statute requires that the specification "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, second paragraph. As the Federal Circuit has observed, reading the invention from the specification into the claims "would render meaningless the statutory requirement for claiming." *SRI Int'l* v. *Matsushita Electric Corp. of America*, 775 F.2d 1107, 1115 n.7 (Fed. Cir. 1985).

The statute also establishes an examination system "centering on the allowance or rejection of claims." *Id.* Once again, this system is rendered meaningless if, after a claim is allowed as written, courts are free to "read into" the claim limitations that are not present in the claim language and that consequently were never considered by the examiner. *Id.* In such a case, the court would not be determining the validity of a claim, but rather would be determining the "validity" of the specification.

The importance of preserving the integrity of the examination system is underscored by the fact that, once the claims are allowed and the patent issues, "[e]ach claim . . . shall be presumed valid," 35 U.S.C. § 282, and an alleged infringer must overcome the presumption of validity by clear and convincing evidence. The analytical basis for the presumption of validity is that the examiner did his job properly, considered the pertinent references, and made a reasoned judgment about the patentability of each claim. *See American Hoist & Derrick Co.* v. *Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir.), *cert. denied*, 469 U.S. 821 (1984). If, however, a court fundamentally changes the nature of a claim by reading into it extraneous

limitations from the specification, the court ends up presuming valid its own construct instead of a claim that was actually passed on by the examiner. A defendant must then prove by clear and convincing evidence the invalidity of a "claim" that was never allowed.

On the other hand, a patentee has no cause to complain if a court refuses to rewrite his claims. He need only apply for a reissue patent containing amended claims. Judge Learned Hand explained:

> We should have no warrant for limiting the claims by the elements of the disclosure which they do not include, even if the elements were new. A patentee who claims broadly must prove broadly; he may not claim broadly, and recede as he later finds that the art unknown to him has limited his invention. That is the chance he must take in making broad claims; if he has claimed more than he was entitled to, the statute does give him a locus poenitentiae, but he must seasonably disclaim the broad claims in toto. *He may not keep them by interpretative limitation; he must procure new claims by reissue.*

Foxboro Co. v. *Taylor Instrument Co.*, 157 F.2d 226, 232 (2d Cir.), *cert. denied*, 329 U.S. 800 (1949) (emphasis supplied). *Accord, Merrill* v. *Yeomans*, 94 U.S. 568, 573 (1876).

In essence, DuPont's claim interpretation argument reduces to the proposition that DuPont wishes the Patent Act and the controlling precedent of this Court and the Federal Circuit were different than they are. This is not a basis for certiorari.

C. DuPont's appeal to "equity" does not warrant review by this Court.

DuPont argues that the Federal Circuit's adherence to the rule against reading limitations into a claim from the specification is somehow inconsistent with other Federal Circuit decisions holding that a patentee cannot assert a broader interpretation of the claim in an infringement suit than he or she

urged in the Patent Office when asking that the claim be allowed. (Pet. 13-15)

As a threshold matter, harmonizing allegedly inconsistent decisions from within a single court of appeals is not generally this Court's task. See Sup. Ct. R. 17. Rather, that is a matter to take up with the particular court of appeals by way of a petition for rehearing in banc. Fed. R. App. P. 35. In this case, DuPont did file a petition for rehearing in banc, but it never even mentioned the supposed intra-circuit conflict that it now says warrants certiorari.[10] This is because no conflict exists.

The supposedly conflicting principle referred to in DuPont's Petition is that, when suing someone for infringement, a patentee is estopped from arguing that the meaning of the claim is any different than the meaning the patentee attached to it during the prosecution of the claim in the Patent Office. This equitable doctrine (called "prosecution history estoppel" or, more archaically, "file wrapper estoppel") ensures that a patentee does not procure a patent by professing a narrow interpretation of the claim and then turn around and sue someone whose products fall outside that interpretation.

This principle has no application where a patentee claims broadly, never attempts to limit the claims, and later finds out that someone else made the claimed invention first. Much less does this equitable doctrine apply where, as here, the patentee first comes up with a brand new interpretation of the claims on the first day of trial.

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[10] DuPont's Petition to this Court cites *Loctite Corp.* v. *Ultraseal Ltd.*, 781 F.2d 861 (Fed Cir. 1985), as its sole example of a case where the Federal Circuit looked to the prosecution history in an infringement suit. (Pet. 14) The *Loctite* decision is not cited anywhere in DuPont's petition for rehearing in banc.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

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